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On June 15, 2006

By Scott Hewett
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PATENT
Attorney Docket No. CP0001US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Inventor: Hung, P.

Application No.: 09/625,442

Filed: 07/26/2000

For: CONFIGURABLE ELECTRONIC
REDEEMABLE COUPON

Examiner: Carlson, J. D.

Art Unit: 3622

**REPLY BRIEF UNDER
37 C.F.R. § 41.41**

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Sir:

A Notice of Appeal and fees for the above-referenced matter was mailed 8/8/2005 in response to the final Office action mailed 5/12/2005. An Appeal Brief was mailed with fees on 10/7/2005. A Notification of Non-Compliant Appeal Brief was mailed 12/29/2005 with a one-month shortened statutory period for response. An Amended Appeal Brief was mailed on 1/27/2006, and an Examiner's Answer was mailed from the U.S. Patent and Trademark Office on 04/20/2006. This Reply Brief is being mailed within two months of the mailing date of the Examiner's Answer in accordance with 37 C.F.R. § 41.41(a)(1). The undersigned believes that no fee is due with this Reply Brief; however, if a fee is due, the Commissioner is hereby authorized to charge any necessary fee for a small entity to USPTO Deposit Account No. 50-0891.

Status of Claims

As stated in the Amended Appeal Brief and confirmed in the Examiner's Answer, claims 2-9, 11-13, and 24 are now pending in the application. Claims 1, 10, and 14-23 have been cancelled. Claims 2-9, 11-13, and 24 have been finally rejected and are on appeal.

Grounds of Rejection to Reviewed on Appeal

As stated in the Amended Appeal Brief and confirmed in the Examiner's Answer, the following issues are on appeal:

A. Whether claims 2-9, 11-13, and 24 are unpatentable as being obvious in light of U.S. Patent No. 5,523,794 by Mankovitz et al. (hereinafter "Mankovitz").

B. Whether claim 8 is unpatentable as being obvious in light of Mankovitz in view of U.S. Patent No. 5,221,838 by Gutman et al. (hereinafter "Gutman").

Argument

This Reply Brief is in addition to, and not a substitute for, the Amended Appeal Brief mailed on January 27, 2006.

On the bottom of page 7 of the Examiner's Answer, the Examiner states that "the [infrared] transmission [of the Mankovitz reference] is nonetheless taken as electronic." The claims on appeal must be analyzed in light of the teachings of the disclosure as they would be interpreted by one of ordinary skill in the art. The Examiner states that "[b]oth RF and IR are in the electromagnetic spectrum, and are taken to be "electronic" transmissions." Can a goldfish be taken to be a horse because they are both animals? Can lead be taken to be gold because they are both elements listed on the periodic table? Can an alpha-numeric display be taken to be a bar code format because each can be scanned? The Examiner must rely on the applicant's disclosure to properly determine the meaning of terms used in the claims. The Examiner is not free to "take" the infrared signal of the cited prior art as an electronic wireless transmission when one of ordinary skill in the art would not do so. The undersigned respectfully requests favorable resolution of this issue based on the totality of the evidence on record.

Regarding claim 8, which recites the configurable portable electronic communication device in the body of the claim, page 3 of the Examiner's Answer states "[t]he Infrared (IR) wireless receiver 16 is taken to be a receiver configured to receive an electronic wireless transmission (an IR signal)". The Examiner is mischaracterizing the reference because Mankovitz labels reference numeral 16 as "an IR detector", not a wireless receiver. One of ordinary skill in the art would not consider the IR detector 16 of Mankovitz to be a receiver configured to receive an electronic wireless transmission. The undersigned respectfully requests favorable consideration of this issue based on the totality of the evidence on record.

The Examiner's comments on page 5 of the Examiner's Answer regarding claims 2-4, 9, 12, 13, take Official Notice that "it is well known that the visual quality of a barcode is related to the success in registering an error-free scan." Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. While "official notice" may be relied on, these circumstances

should be rare when an application is under final rejection. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known in the art are capable of instant and unquestionable demonstration as being well-known.

The Examiner then states that “Bushnell’s Bar Code reference supports this and one of ordinary skill would recognize the same relationship between visual clarity and scanning success regardless of whether the barcode was printed or electronically displayed”, but does not indicate where such support appears in this reference, or even what the Examiner means by “visual quality” or how it is different from “visual clarity”. The Examiner further discusses “visual quality” on page 9 of the Examiner’s Answer, but the reasoning appears somewhat circular in that the Examiner uses the term “visual quality” to represent visually presented barcodes- regardless of whether they are to be printed or electronically displayed, and then asserts “visual clarity” is notoriously important when scanning a barcode. However, electronically displayed barcodes have attributes, such as persistence, that printed barcodes do not.

The Appellant teaches in the as-filed specification (e.g. page 6, lines 9-10; page 6, lines 21-23) instances where electronic display attributes for scannability diverge from visual considerations. Similarly, the Bushnell reference (page 227) indicates that printing barcodes using carbon-based ink allows scanners to often read symbols when they are contaminated by marks from ball point pens, dirt, or other foreign matter. In light of Bushnell, such conditions would reduce visual clarity/quality while allowing scannability of printed barcodes. However, using carbon-based ink is not an option for electronically displayed barcodes.

On page 9 of the Examiner’s Answer, the Examiner cites Col. 4, lines 3-6 of U.S. Patent No. 5,521,371 by Hotta et al. (“Hotta”) for allegedly teaching “the desire improved scanning accuracy via a high contrast display when displaying an electronic barcode on an electric display.” Hotta is directed at a thermally rewritable bar code display medium (Abstract). Figure 1(a) of Hotta shows a barcode display medium with a reflective or pigment layer 14 beneath a recording layer 12, such as a resin matrix and a low-molecular weight organic material dispersed in the resin matrix that it thermally

sensitive. A thermal head 4 is used to form a barcode in the medium, which is described as being "card-type" (Col. 9, line 4). One of ordinary skill in the art, in view of the entirety of Hotta's disclosure, would not consider the card-like medium with thermosensitive pigment to be an electronic display as taught in the Applicant's disclosure, and the undersigned believes Hotta is being mischaracterized.

The evidence on record indicates different considerations arise when scanning printed versus electronically displayed barcodes. Hotta does not disclose displaying an electronic barcode on an electronic display. The conclusory statements provided by the Examiner are inadequate, and the Examiner's notice is improper. The undersigned respectfully requests favorable consideration of this issue based on the totality of the evidence on record.

Regarding the rejection of claim 8 over Mankovitz in view of Gutman on page 7 of the Examiner's Answer, the Examiner states that Gutman teaches that several different bar code formats "can be supported by the device." Gutman discloses an electronic wallet with the ability to scan different bar code formats. Claim 8 recites a memory containing a computer-readable program "including instructions for converting the scannable coupon from a first scannable barcode format to a second scannable barcode format." Gutman does not teach or suggest this limitation of claim 8.

Gutman teaches away from claim 8 because the ability of the electronic wallet to scan various barcode formats avoids the need for a portable electronic communication device to be able to convert between scannable barcode formats. An analogy might be a device (Gutman's electronic wallet) with a hole that can accept a round peg or a square peg (can scan various barcode formats). If either type of peg fits into the hole, there is no need to convert one type of peg to the other. More importantly, the device would not convert a round peg into a square peg (convert one type of displayed barcode format into another), or vice versa. Gutman does not disclose a memory containing a computer-readable program including instructions for converting the scannable coupon from a first scannable barcode format to a second scannable barcode format. The undersigned respectfully requests favorable resolution of this issue based on the totality of the evidence on record.


On page 8 of the Examiner's Answer, the Examiner urges that "[e]ven in a local environment, different retailers could support/employ/honor different barcode formats for an advertised product." The fact that the prior art could have been modified is not the proper standard for determining patentability. The Examiner must show where one of skill in the art would have found motivation to modify the reference without access to the application under examination. The Examiner appears to be relying on hindsight reasoning, and using the Appellant's own teachings from page 5, lines 5-21 as the motivation for the urged modification, which is impermissible. The undersigned respectfully requests favorable resolution of this issue based on the totality of the evidence on record.

On page 9 of the Examiner's Answer, the Examiner states that the "Applicant is not believed to have seasonably challenged the initial Official Notice regarding general knowledge that pixels and anti-reflective contrast coatings are ways to achieve a quality display." The undersigned disputes this assertion and respectfully directs the Board's attention to page 7 of the Amendment in response to the first Office action, which was mailed 03/14/2003, and to page 8, ¶ 3 - page 9, ¶ 1 of the Amendment After Final Rejection filed in response to the Office action mailed 08/25/2003. It is unclear to the undersigned how the challenges could have been any more seasonable. Since the Examiner has raised this issue in the Examiner's Answer, resolution of this issue in light of the totality of evidence on record is respectfully requested.

For the reasons given above, in the Amended Appeal Brief, and the totality of the evidence on record, the Appellant respectfully requests that all rejections be overturned and all claims allowed.

Date: June 15, 2006

Respectfully Submitted


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